

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86290979
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86290979/large
LITERAL ELEMENT	PETALO
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<p style="text-align: center;"><u>RESPONSE TO OFFICE ACTION</u></p> <p>This is in response to the Office Action dated April 6, 2015.</p> <p style="text-align: center;"><u>Remarks</u></p> <p>In response to the final refusal based on an alleged likelihood of confusion with U.S. Registration No. 3,557,567, submitted herewith is a Consent to Use and Register (the "Consent") executed on October 5, 2015 by the Applicant and the Registrant. It is respectfully submitted that the Consent further supports Applicant's previously submitted arguments that there is no likelihood of confusion between PETAL SOFT and PETALO.</p> <p>The Consent states, inter alia, that the parties, "having considered their long time co-existence on the register and in the marketplace, agree that they are not aware of any past or present confusion in the marketplace between the respective goods sold in connection with their respective marks, and do not expect any confusion in the future.....and agree to make any further agreements necessary and take action to prevent and/or remedy any such confusion should it arise in the future."</p> <p>Accordingly, the Applicant and Registrant have each concluded that the co-existence in the marketplace of each of their bathroom tissue and facial tissue products under their respective trademarks has not caused, and is not likely in the future to cause, confusion. Applicant and Registrant are both</p>	

extremely familiar with the marketplace for their respective products, and have co-existed therein for at least seven (7) years without confusion between their PETAL SOFT and PETALO products having arisen. Surely either or both parties would be aware of confusion amongst consumers or retailers or others in the marketplace had there been any during a lengthy period of co-existence. Moreover, the parties each have a significant interest in avoiding confusion in the future, and have agreed to do whatever is necessary to prevent and remedy any confusion that would arise.

As recognized in TMEP 1207.01(d)(viii), in its *In re E. I. du Pont de Nemours & Co.* decision, the Court of Customs and Patent Appeals stated as follows: “[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won’t. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.” 476 F.2d at 1363, 177 USPQ at 568.

In view of the foregoing, withdrawal of the refusal to register is again most respectfully requested. Applicant is today submitting a Notice of Appeal, in the event that the Examining Attorney is unwilling or unable to withdraw the refusal in advance of the deadline.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_7420699126-20151005194544354511_10-5-2015_Executed_Consent_to_Use_and_Register_-_PETALO.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\862\909\86290979\xml7\RFR0002.JPG
DESCRIPTION OF EVIDENCE FILE	scanned copy of October 5, 2015 Consent to Use and Register

SIGNATURE SECTION

RESPONSE SIGNATURE	/Susan Stone Rosenfield/
SIGNATORY'S NAME	Susan Stone Rosenfield
SIGNATORY'S POSITION	Attorney of record
DATE SIGNED	10/05/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Mon Oct 05 19:55:47 EDT 2015
	USPTO/RFR-74.206.99.126-2 0151005195547043345-86290 979-54068e0d8c5cc701d8ccb

TEAS STAMP

89e387f8c2417bd65139410f8
701aadd999ce77b4d29c-N/A-
N/A-20151005194544354511

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **86290979** PETALO(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86290979/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

RESPONSE TO OFFICE ACTION

This is in response to the Office Action dated April 6, 2015.

Remarks

In response to the final refusal based on an alleged likelihood of confusion with U.S. Registration No. 3,557,567, submitted herewith is a Consent to Use and Register (the "Consent") executed on October 5, 2015 by the Applicant and the Registrant. It is respectfully submitted that the Consent further supports Applicant's previously submitted arguments that there is no likelihood of confusion between PETAL SOFT and PETALO.

The Consent states, inter alia, that the parties, "having considered their long time co-existence on the register and in the marketplace, agree that they are not aware of any past or present confusion in the marketplace between the respective goods sold in connection with their respective marks, and do not expect any confusion in the future.....and agree to make any further agreements necessary and take action to prevent and/or remedy any such confusion should it arise in the future."

Accordingly, the Applicant and Registrant have each concluded that the co-existence in the marketplace of each of their bathroom tissue and facial tissue products under their respective trademarks has not caused, and is not likely in the future to cause, confusion. Applicant and Registrant are both extremely familiar with the marketplace for their respective products, and have co-existed therein for at least seven (7) years without confusion between their PETAL SOFT and PETALO products having arisen. Surely either or both parties would be aware of confusion amongst consumers or retailers or others in the marketplace had there been any during a lengthy period of co-existence. Moreover, the parties each have a significant interest in avoiding confusion in the future, and have agreed to do whatever is necessary to prevent and remedy any confusion that would arise.

As recognized in TMEP 1207.01(d)(viii), in its *In re E. I. du Pont de Nemours & Co.* decision, the

Court of Customs and Patent Appeals stated as follows: “[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won’t. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.” 476 F.2d at 1363, 177 USPQ at 568.

In view of the foregoing, withdrawal of the refusal to register is again most respectfully requested. Applicant is today submitting a Notice of Appeal, in the event that the Examining Attorney is unwilling or unable to withdraw the refusal in advance of the deadline.

EVIDENCE

Evidence in the nature of scanned copy of October 5, 2015 Consent to Use and Register has been attached.

Original PDF file:

[evi_7420699126-20151005194544354511_10-5-2015_Executed_Consent_to_Use_and_Register_-_PETALO.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Susan Stone Rosenfield/ Date: 10/05/2015

Signatory's Name: Susan Stone Rosenfield

Signatory's Position: Attorney of record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86290979

Internet Transmission Date: Mon Oct 05 19:55:47 EDT 2015

TEAS Stamp: USPTO/RFR-74.206.99.126-2015100519554704

3345-86290979-54068e0d8c5cc701d8ccb89e38

7f8c2417bd65139410f8701aadd999ce77b4d29c

-N/A-N/A-20151005194544354511

CONSENT TO USE AND REGISTER

WHEREAS, WESTERN FAMILY FOODS, INC., a corporation of Oregon, having an address at 6700 S.W. Sandburg Street, Tigard, Oregon 97233, is the owner of U.S. Trademark Registration No. 3,557,567 for the mark PETAL SOFT for "bathroom tissue and facial tissue"; and

WHEREAS, ROYAL PAPER CONVERTING, INC., a corporation of Arizona, having an address at 711 N. 17th Avenue, Phoenix, Arizona 85007, is the owner of U.S. Trademark Application No. 86/290,979 for the mark PETALO for "bathroom tissue; facial tissue; paper napkins; paper towels".

NOW THEREFORE, in consideration of the agreements set forth below, the adequacy of which is hereby acknowledged, the parties agree as follows:

1. Western Family Foods, Inc. consents to the registration and use by Royal Paper Converting, Inc. of the mark PETALO, with and without design or stylization, for "bathroom tissue; facial tissue; paper napkins; paper towels".
2. Royal Paper Converting, Inc. consents to the registration and use by Western Family Foods, Inc. of the mark PETAL SOFT, with and without design or stylization, for "bathroom tissue and facial tissue".
3. Western Family Foods, Inc. and Royal Paper Converting, Inc., having considered their long time co-existence on the register and in the marketplace, agree that they are not aware of any past or present confusion in the marketplace between the respective goods sold in connection with their respective marks, and do not expect any confusion in the future between the respective goods sold in connection with their respective marks, as long as the provisions of this Consent to Use and Register are abided by, and agree to make any further agreements necessary and take action to prevent and/or remedy any such confusion should it arise in the future.
4. Each party agrees to execute any further documents reasonably requested by the other party to effectuate the terms of this Consent to Use and Register Agreement.
5. The rights and obligations of the parties as provided by this Consent to Use and Register Agreement shall be binding upon each party's assigns, successors, heirs and licensees.

WHEREFORE, the parties have caused this Consent to Use and Register Agreement to be executed by their duly authorized officers as follows:

WESTERN FAMILY FOODS, INC.

This 5th day of October, 2015

By: Pete J. Craven

Name: Pete J. Craven
Title: Senior VP and CFO

ROYAL PAPER CONVERTING, INC.

This 5th day of October, 2015

By: Sunil Kanuja

Name: SUNIL KANUJA
Title: cto